

### **REMARKS/ARGUMENTS**

The present remarks are submitted in response to the office action dated June 19, 2007 in the above-identified application. Filed concurrently herewith is a request for three (3) month extension of time making the present response due no later than December 19, 2007.

In the most recent office action the examiner has withdrawn the previous rejections of the claims in view of applicant's remarks filed on or about March 19, 2007. The examiner has, however, entered new grounds of rejections for the various claims. While the office action is quite lengthy, the overriding basis for the examiner's rejections of the claims can be summarized. On the one hand, the examiner rejects claim 5 under 35U.S.C. Section 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the examiner maintains that it is unclear as to the meaning of the phrase "a common ordered arrangement." In examining the claim, the examiner has apparently adopted a reasonably broad interpretation so that this phrase encompasses items which can be arranged alphabetically or numerically, for example.

As to the rejections over the art, each of claims 1-43 is rejected under 35U.S.C. Section 103(a) as being unpatentable over "Microsoft Word 2000," copyright 1999 (hereinafter "MS Word"), in view of US Patent Number 7,203,900 to Nara et al (hereinafter "Nara") and in view of publication number 2007\0011607 A1 to Lazareck et al ("Lazareck").

Turning first to the rejection under 35U.S.C. Section 112(b), applicant respectfully submits that this rejection is misplaced. Indeed, the phrase "a common ordered arrangement" is rather self explanatory. This phrase is used in Claim 5 to recite the manner in which the digital images populate both the first and second working areas. In particular, the phraseology contemplates that the digital images in each of these first and second working areas are displayed in a manner which is the same and which is arranged in a selected order.

Accordingly, applicant agrees that it is reasonable for the examiner to interpret this phrase to contemplate arrangements which are alphabetical or numerical, to name only a few representative possibilities.

It is unclear to applicant precisely why the examiner feels this phraseology is indefinite. It is the examiner's burden of providing evidence of a *prima facie* case to support an indefiniteness rejection under 112(b). Thus, the examiner has the burden of showing that the proposed claim language is indefinite to one of skill in the art. On the one hand, the examiner's rejection has not been made in the context of what would be indefinite, or definite, to one of skill in the art. According to the Federal Circuit Court of Appeals, claims are definite under Section 112(b) if, when read in light of the specification, they reasonably apprise those skilled in the art in the use and scope of the invention, and if the language is as precise as the subject matter permits. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, *cert. dismissed*, 474 U.S. 976 (1985). In determining whether this standard is met, the Federal Circuit has not held that a claim is indefinite merely because it poses a difficult issue of claim construction. *Exxon Research & Engin'g Co. v. United States*, 265 F.3d 1371 (Fed. Cir. 2001). Definiteness of claim language must be analyzed not in a vacuum, but in light of such elements as (1) the content of the particular application disclosure, (2) the claim interpretation that would be given by one of ordinary skill in the pertinent art at the time the invention was made, and (3) the teachings of the prior art. Thus, the examiner has the burden of providing a specific rejection of claim terminology and reasons why the examiner believes the terminology is indefinite or would not readily be understood by those of skill in the art. It is, therefore, respectfully submitted that the examiner has failed to meet his burden of establishing a *prima facie* rejection of claim 5 under Section 112, second paragraph.

As to the various claim rejections set forth on pages 3-37, applicant respectfully submits that these various rejections are also misplaced. It is noted that the application contains various independent claims, namely, independent

claims 1 and 15 directed to computerized methods, independent claim 20 directed to a computer-readable medium, independent claims 28, 37 and 42 directed to systems, and independent claim 43 directed to an electronic literary work. Of these, independent claims 1, 20, and 43 contemplate a second working area of the application program which can be populated with selected digital images from an imported set to establish a working image set. The examiner maintains, for example on page 4 of the office action, that "[u]sing the broadest reasonable interpretation, the examiner concludes the second dialogue box/window displaying clip-art relating to the second category is analogous to populating a second working area." Applicant strongly disagrees. The referenced dialogue box [the ClipArt Gallery dialogue box/window of MS Word (Fig. 4)] is hardly akin to a working area within the application program. This is evidenced by the fact that only images from the dialogue box can be selected. They cannot be worked with to compose portions of an electronic work as specifically contemplated by independent claims 1, 20, and 43. When these claims are regarded as a whole, it becomes clear that the second working area is used to establish an underlying working image set for arranging images and associating image data with them. It is respectfully submitted that it is simply error for the examiner to regard the dialogue box from MS Word as a working area because it is basically stagnant and incapable of being edited. Such an interpretation of the prior art effectively ignores applicant's claimed term working which contemplates, without question, an area within which a user can begin to compose portions of the electronic literary work. Accordingly, it is respectfully submitted that the examiner has misconstrued the teachings of, and in fact the capabilities of, the clip art gallery dialogue box/window of MS Word and, therefore, any combination of this reference with the various features of Nara and/or Lazareck would not reasonable result in the inventions of independent claims 1, 20, or 43 when these claims are regarded as a whole.

Applicant additionally maintains that the examiner's purported combination of the teachings of Nara and Lazareck with MS Word fails to meet the objective

standards under 35U.S.C Section 103. It is noted that the examiner refers on page 5 of the office action to the identical portion of the Nara reference (col. 25, lines 47-col. 26, line 67; fig. 43-fig. 45) for the proposition that Nara teaches both "arranging the digital images which comprise said working image set into a selected storyboard sequence" and "displaying the pairs of companion image items on the display according to said story board sequence". According to the recitations in independent claims 1, 20 and 43 of the present application, the pairs of companion image items (as that term is used) do not exist until image data is associated with at least some of the digital images in the working image set. See, for example, sub-paragraph (e) of independent claim 1. The examiner instead looks to the teachings of Lazareck to find this intermediate step. Accordingly, to the extent the examiner relies on an independent reference (namely Lazareck) for the teaching of associating image data with digital images in the working set to define the pairs of companion image items, then the cited passage of Nara could not logically teach both the precursor and successor to the step which creates the pairs of companion image items in the first place. Stated somewhat differently, if Nara fails to even teach the creation of companion image items, then how can the examiner rely upon Nara as teaching "displaying the pairs of companion image items on the display according to said story board sequence"?

In issuing its opinion *KSR Int'l. Co. v. Teleflex, Inc.*, the Supreme Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. Section 103(a). Notably, however, the Supreme Court did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis; rather, the Court rejected a rigid application of the TSM test. Indeed, in formulating a rejection under 35U.S.C. Section 103 (a) based upon a combination of prior art elements, it remains necessary for the examiner to identify the reason why a person of ordinary skill in the art would have combined the prior elements in the manner claimed. In the office action, the examiner states that "it would have been obvious to one of ordinary skill in the art

to combine MS Word with Nara for the benefit of displaying the structure of an edited book file in a preview window so that the user can visually confirm the book file layout without printing it, therefore increasing the editing operability." Further, the examiner maintains that the ordinarily skilled artisan would have found it obvious "to combine MS Word and Nara with Lazareck for the benefit of producing customized books." However, such rationale fails not only to: (1) explain how the same portion of Nara teaches both steps (d) and (f) for example of claim 1, but also (2) a reason why the ordinarily skilled artisan would have combined the teachings of Lazareck with Nara to generate companion image items. It is respectfully submitted that, without such motivation, one would not even be inclined to generate companion image items in Nara.

For similar reasoning, the examiners failed to establish with reference to independent claim 15 how Nara can teach arranging pairs of companion image items when the claim incorporates a precursor step of correlating respective image data with each of the digital images in order to define pairs of companion image items in the first place. See also independent claim 28 which contemplates a system having a composition component creating the electronic literary work wherein pairs of companion image items are defined by associating user-defined image data with digital images. See also sub-paragraphs (d)(iv) in the systems of independent claims 37 and 42.

Moreover, the Federal Circuit has held that conclusory statements of generalized advantages and convenient assumptions are inadequate to support a finding of motivation to combine prior art references for a proper obviousness rejection. *In re Beasley*, Civ. App. 04-1225, slip op. at 6-7, 2004 WL 2793170 (Fed. Cir. Dec. 7, 2004). It is submitted that this is precisely what the Examiner has done in the present case with respect to all of the rejections. More particularly, The examiner notes that the combination of MSWord with Nara would increase editing operability to confirm layout prior to printing, and that the combination of MSWord with Nara and Lazareck would be for the benefit of producing customized books. However, such reasoning by the examiner rests

on generalized statements of advantages without regard to the desirability or the feasibility of making the purported modifications.

Applicant would also like to note its disagreement with the examiner's characterization on page 11 of the office action as it relates to the rejection of dependent claims 12 and 25 that Nara teaches "generating a front cover and a back cover for the electronic literary work". In support of the rejection, the examiner states "Nara teaches a preview display which displays the images in the arranged order as they would appear within the electronic literary work." This, however, says nothing about front cover and back covers which may have different characteristics from those pages within the work and may not even be composed of pairs of companion image items. Even assuming arguendo that Nara teaches the ability to preview images, it does not follow that the reference teaches the generation of front and back covers for electronic literary works.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the Applicant at the telephone number listed below.

Respectfully submitted,

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